

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 11-20 are now present in this application. Claims 11 and 16 are independent.

Claims 11 and 16 have been amended and amendments have been made to the specification. Reconsideration of this application, as amended, is respectfully requested.

Information Disclosure Citation

Applicants thank the Examiner for considering the references supplied with the Information Disclosure Statement filed September 4, 2003, and for providing Applicants with an initialed copy of the PTO-1449 form filed therewith.

**Drawings**

Applicants submitted proposed drawing corrections in the form of proposed replacement sheets in the Amendment filed February 3, 2004. The Examiner has not indicated that those replacement sheets were entered and, based on the "new matter" objection, discussed below, assumes that those proposed replacement sheets were not entered.

If the proposed replacement sheets were not entered, then Applicants need do no more. However, if the proposed replacement sheets were entered, Applicants respectfully request that the original drawing sheets they were proposed to replace be substituted therefor.

In any event, Applicants would appreciate clarification of this issue in the next Office Action.

Specification Objection

The Examiner has objected to the specification because of the alleged introduction of new matter per 35 USC 132. Applicants respectfully disagree with the position that substitution of “related art” for “conventional” art involves new matter. Something can be both conventional and related, as is the situation in this Application. Nevertheless, solely in order to remove this issue from consideration, including a possible appeal, Applicants have amended the specification in order to restore the originally disclosed “conventional” language and remove the previously added “related art” language. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Amendments

Claims 11 and 16 are amended to delete the indication that the reflective electrode is connected to the switching element. An inspection of Figs. 11C to 11E and the associated disclosure in the body of the specification reveals that this is not a correct statement.

Rejections under 35 U.S.C. § 103

Claims 11-14 and 16-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over “the admitted prior art” in view of U.S. Patent Application Publication 2002/0118322 to Murade. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In the first place, Applicant has not admitted that Figures 1-7 are prior art to them. In Eleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v. Barron et al., 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicant has done is to refer to Figs. 1-7F as “Conventional Art.”

Something can be conventional art in the sense that it is practiced in the real world at the time of Applicant's filing of this Application and may yet not be prior art to Applicant in any sense, including, for example, under 35 USC §103, which forms the basis for this rejection. See, in this regard, the relatively recent amendments to 35 USC 103(c).

The assertion on page 6 of the Office Action that "Applicant is indicating that said subject matter was known and available to the public at the time the invention was made" is only speculation. As is well settled, a rejection based on Section 103 must rest on a factual basis. An Examiner has the initial duty of supplying the factual basis for the rejection he advances. An Examiner may not, because of doubts that the invention is patentable, resort to speculation or unfounded assumptions to supply deficiencies in the factual basis. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Under the circumstances, i.e., where Applicant merely describes Figs. 1-7F as conventional art, the Office Action has not established that Applicant has made a clear, unequivocal and unmistakable admission on the record that what is disclosed in Figs. 1-7F is prior art to Applicant. In this regard, the Examiner is also advised that the initial burden to establish something as prior art is on the Office as part of its burden of making out a *prima facie* case of unpatentability.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicant respectfully submits that the Office has not made out a *prima facie* case of unpatentability at least because it has not made out a *prima facie* case that Figs. 1-7F are prior art to Applicant.

In the second place, the Office Action fails to provide any objective evidence of proper motivation to modify Figs. 1-7F, which have not been established to be prior art to Applicant, in view of the secondary reference to Murade.

In rejecting claims under 35 USC 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching,

suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir.

1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The alleged reason that one of ordinary skill in the art would have the desire to modify Figs. 1-7F in view of Murade is "for the purpose of selecting a material for the first layer that has good lattice matching with the substrate and using a material for the second layer that can be easily smoothed." Applicants respectfully submit that this reason is not "clear and particular", but is merely a broad conclusory statement about general principles of lattice matching and smoothness and, standing alone, is not "evidence" of proper motivation to modify Figs. 1-7F in view of Murade. See In re Dembiczak, cited above.

Moreover, in making a rejection under 35 USC §103, the prior art as a whole must be considered. The teachings of the applied references are to be viewed as they would have been viewed by one of ordinary skill in the art. Kimberly-Clark v. Johnson & Johnson, 745 F.2d 1437, 1454, 223 USPQ 603, 614 (Fed. Cir. 1984); In re Mercier, 515 F.2d 1161, 1165, 185 USPQ 774, 778 (CCPA 1975). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of

what such reference fairly suggests to one of ordinary skill in the art". In re Wesslau, 353 F.2d at 241, 147, USPQ at 393. In re Hedges, et al., 228 USPQ 685 (Fed. Cir. 1986).

In this instance, the Office Action has not established any prior art for Murade to modify.

Moreover, Figs. 1-7F, which have not been established as prior art to Applicants under 35 USC 103(c), do not indicate any problems to be solved. Only Applicant's disclosure discloses a problem to be solved and a solution for that problem – see, for example, page 6 of Applicant's disclosure.

This rejection is treating Applicant's disclosure regarding a problem to be solved as prior art with no proper basis on which to do so. In making its determination the prior art must be viewed without reading into that art the patent's teachings. In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). Moreover, "discovery of the source of a problem" is part of the "subject matter as a whole" to be considered in determining obviousness – see Sponnoble, cited above.

In this regard, the Office Action provides no objective evidence of prior art disclosing the problem that Applicant overcomes.

Instead, this rejection is a prime example of improper hindsight reconstruction of Applicant's invention based on Applicant's own disclosure of his invention, and that is fundamentally improper.



Additionally, claim 11 recites the reflective electrode on and directly contacting the first passivation layer as a separate element from the gate line and data line. In Murade, "electrode 3" is actually the data line and, thus, is not a separate element from the data line. However, as disclosed and claimed, Applicants' reflective electrode is a separate element from the gate line and the data line.

This difference would tend to teach away from using Murade to place a reflective electrode other than the gate line or data line on a first passivation layer.

Similar comments apply to the similarly featured method steps of independent method claim 16.

Accordingly, this rejection of claims 11-14 and 16-19 is improper and should be withdrawn.

Claims 15 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "the admitted prior art" in view of U.S. Patent Application Publication 2002/0118322 to Murade as applied in the rejection of claim 16, and further in view of U.S. Patent 6,157,426 to Gu. This rejection is respectfully traversed.

The "admitted prior art" – Murade reference combination is improper for reasons stated above. Moreover, Gu is not applied to remedy the impropriety of that reference combination, nor does Gu provide such a remedy.

Accordingly, this rejection is improper and should be withdrawn.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No.: 10/028,759  
Art Unit 2815

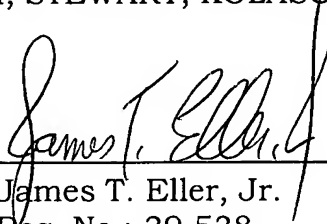
Attorney Docket No. 3430-0174P  
Reply to April 13, 2004 Officer Action  
Page 24

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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